

THIS DECISION IS NOT
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OF THE TTAB

Paper No. 16

TJQ

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Proteus S.A.

Serial No. 75/625,873

John A. Clifford and Kristina M. Foudray of Merchant & Gould for applicant.

Tracy L. Fletcher, Trademark Examining Attorney, Law Office 115 (Tomas Vlcek, Managing Attorney).

Before Cissel, Quinn and Hairston, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Proteus S.A. to register the mark PHENOMICS for "industrial enzyme research in the chemical and agricultural fields."¹

The Trademark Examining Attorney refused registration under Section 2(e)(1) of the Trademark Act on the ground

¹ Application Serial No. 75/625,873, filed January 25, 1999, alleging an intention to use the mark in commerce and a claim of priority under Section 44(d) based on a French application.

that applicant's mark, if used in connection with applicant's services, would be merely descriptive of them.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney filed briefs. An oral hearing was not requested.

Applicant, while stating that "the term 'phenomics' may relate in some way to the field of molecular biotechnology," argues that its mark is just suggestive, and that the Examining Attorney has not met her burden to show that the mark is merely descriptive. Applicant contends that there are numerous possible interpretations of the term "phenomics," suggesting that the term means "that something is 'phenomenal,'" or that the term "may be a play on the word 'fee' such as 'feenomics.'" Applicant also points to the existence of a third-party registration which initially was cited as a Section 2(d) bar to the registration sought by applicant. Applicant asserts that the registration of PHENOMICS for consultation and information services in the fields of medicine and genetics shows that applicant's mark should be registered too. Applicant is critical of the Examining Attorney's evidence, maintaining that none of the references to the term "phenomics" relates to industrial enzyme research in the chemical and agricultural fields. At best, applicant

argues, the evidence "demonstrates that the term phenomics may be descriptive of certain pharmaceuticals, analysis of specific multiple proteins, and limited medical uses." Lastly, applicant urges that any doubt be resolved in its favor, thereby allowing others in the industry an opportunity to oppose the registration sought by applicant. Applicant has submitted one of its brochures covering its services. Applicant's literature states that applicant "is a contract research company for the biotech industry" with research focus on "the discovery and the design of novel industrial enzymes" and "the design of rapid nucleic acid analysis techniques." The literature identifies PHENOMICS as applicant's proprietary technology for biodiversity screening.

The Examining Attorney maintains the record shows that "phenomics" is the name for a new field of scientific study involving phenotypes and which complements genomics, and that the term has been used in reference to the study of the anatomy and function of cells and whole organisms. In support of the refusal, the Examining Attorney submitted dictionary definitions,² and articles retrieved from the

² Pursuant to the Examining Attorney's request to take judicial notice, the new dictionary listings cited in her brief have been considered. See: *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

NEXIS database and the Internet.

It is well settled that a term is considered to be merely descriptive of services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes a quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or feature about them. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the services for which registration is sought. In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979).

The term "phenotype" is defined as "the totality of the observable functional and structural characteristics of an organism as determined by interaction of the genotype of the organism with the environment in which it exists; any particular characteristic or set of characteristics of an organism so determined; a group of organisms exhibiting the same set of such characteristics." The term "phenome" means "the whole of the phenotypic characteristics of an

organism." Oxford Dictionary of Biochemistry and Molecular Biology (revised ed. 2000). The Internet and NEXIS database evidence reveals widespread use of the term "phenomics" in connection with an emerging field of scientific study. The following are examples of these uses:

The study of the genotype-phenotype relationship, through the use of genomic data and analysis of multigeneic functions in this manner, constitutes a field of its own; one which may be called "phenomics." Phenomics is expected to rise as a new scientific endeavor, one that seeks to analyze, interpret, and predict the genotype-phenotype relationship from genomic data. Given all the biological data and computer power available today, the development of phenomics seems inevitable...this method can be used for a broad range of scientific interests, all related to the deepest goal of understanding the genotype-phenotype relationship.
(*American Chemical Society and American Institute of Chemical Engineers*, April 24, 1999)

Phenomics will be based on the study of integrated cellular systems and basic physical-chemical laws.
(*Gene Therapy Weekly*, August 9, 1999)

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Phenomics is a field of study borne from the completion of the human genome project to effect this end. Simply put, it is study of genomic information to better understand the complex relationship between genotype and phenotype.
(www.dnaprint.com)

Based on the evidence of record, we find that the mark is merely descriptive of industrial enzyme research in the chemical and industrial fields that involves the study of genotype-phenotype relationship. Although applicant contends that the descriptive meaning is confined to the pharmaceutical and medical fields, the Examining Attorney's evidence shows that phenomics has much broader

applicability, including to the chemical and agricultural fields. In any event, as pointed out by the Examining Attorney, applicant's recitation of services, which includes enzyme research in the chemical field, is broad enough to encompass pharmaceutical and medicinal chemistry.

The existence of a single third-party registration for the mark PHENOMICS does not compel a different result in this case. In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ["Even if some prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the Board or this court."]. While uniform treatment under the Trademark Act is an administrative goal, our task in this appeal is to determine, based on the record before us, whether applicant's particular mark sought to be registered here is merely descriptive of the services recited in the application. As is often stated, each case must be decided on its own merits. See, e.g.: In re Best Software Inc., 58 USPQ2d 1314 (TTAB 2001).

Decision: The refusal to register is affirmed.